

AMENDMENT AFTER FINAL
Serial No. 09/945,378
Docket No. CGR03-GN003

REMARKS

Introductory Comments

Claims 2-7, 10-13, 15-20, and 23-32 have been canceled without prejudice; a new Abstract is provided. Reconsideration of the application is respectfully requested.

Specification

The ABSTRACT is objected to because it exceeds 150 words. The specification has been amended to provide a new ABSTRACT to overcome this objection.

Claim Rejections under 35 USC §103

Claims 2-4, 12, 13, 16, 17, 24, and 26-32 are rejected as being allegedly obvious over US Pat. No. 6, 764,395 to Guyett. Claims 5-7, 10, 11, 15, 20 and 23 are rejected as being allegedly obvious over Guyett in view of US Pat. No. 5,679,075 to Forrest. Claim 25 is rejected as being allegedly obvious over Guyett in view of US Pub. No. 2004/0225558 to Lipin. Claims 18 and 19 are rejected as being allegedly obvious over Guyett in view of Forrest and in further view of US Pat. No. 6,595,859 to Lynn. Claims 2-7, 10-13, 15-20, and 23-32 have been cancelled without prejudice; thus, the above rejections are presently moot.

Claims 33-37, 42, 44-49 and 64-70 are rejected as being allegedly obvious over Guyett in view of US Pub. No. 2003/0191690 to McIntyre. This rejection is respectfully traversed for the following reasons.

Claims 33/67 require the following three steps (in addition to the other steps recited in each respective claim):

- gathering data associated with the consumer's interactions with the present interactive advertising message/computerized game;
- generating a statistical report from the data; and
- providing the statistical report to the commercial entity

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On page 7 of the final Office action it is admitted that Guyett does not specify generating a statistical report and sending it to the commercial entity as claimed by claims 33 and 67. However the final Office action argues that McIntyre "teaches a statistical report that keeps track of how many times a game is played and the sending of this report to sponsors of the game (Paragraph 0008)." This interpretation of McIntyre is incorrect.

McIntyre only teaches a computer game where advertising images of various sponsors are provided to the game, where the game system keeps track of the use of the advertising images so that the sponsors can be appropriately billed. The process of McIntyre cited by the final Office action is explained in slightly more detail in paragraph [0042] of McIntyre:

The host server may keep track of the number of times the games are played and to which sponsor the game is being played. In another form of the present invention, the games may be dispensed by the host server 26 in accordance with a predetermined schedule. Thus keeping track of the number of times a sponsor message contest and/or message is received. This also allows a sponsor to be billed for the actual number of times games have been played on their behalf.

In other words, McIntyre neither teaches the generation any statistical report as claimed, nor does it teach the step of providing that statistical report to the commercial entity as claimed. At best McIntyre teaches a step of billing a sponsor according to the number of times a sponsor's advertising is received.

This is significant for several reasons. First, a billing amount of McIntyre is not a statistical report as claimed; second, the billing amount of McIntyre is only processed based upon the number of times a sponsor's advertising is received, rather than the data associated with the consumer's interactions with the present interactive advertising message/computerized game as claimed; and third, McIntyre does not even disclose a step of sending a bill, a report, or anything similar to the commercial entity -- the final

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step of "providing the statistical report to the commercial entity" as claimed is completely absent.

Consequently, even if Guyette and McIntyre were combined as argued by the final Office action, one of ordinary skill still would not be motivated to reach the invention as claimed in claims 33/67 because neither reference teaches either: (a) generating a statistical report from the data [associated with the consumer's interactions with the present interactive advertising message/computerized game]; or (b) providing the statistical report to the commercial entity.

In an apparent attempt to compensate for the failings of the prior art, the Examiner makes an unsubstantiated argument that "[i]t would have been obvious to one having ordinary skill in the art at the time of the invention was made to provide a report to the commercial entity. This would aid the commercial entity in knowing how well-received their game is." Applicant respectfully disagrees and traverses this argument.

Significantly, neither Guyett nor McIntyre provide any indication whatsoever of the *market-research* functionality and purpose of the invention as claimed in claims 33 and 67. Guyett only collects data associated with consumer's interactions to computer a payoff or prize to the consumer (referring to col. 10, lines 17-20 as cited by the final Office action); and, as discussed, above, McIntyre does not even teach collecting data associated with consumer interactions at all, but counts the number of ads provided for a sponsor to calculate a bill to that sponsor. It's no wonder, then, that neither of these references teach the claimed steps of generating and providing the statistical report as claimed. Certainly, while such market-research uses of the interactive advertising message/computerized game of the present invention may seem advantageous *in hindsight*, they were clearly not recognized by either Guyett nor McIntyre. Thus, one of ordinary skill at the time of the invention, would certainly not see the need to modify either or both of Guyett nor McIntyre as suggested by the Examiner. While it may seem apparent to the Examiner in hindsight that providing a report to the commercial entity would "aid the commercial entity in knowing how well-received their game is," the

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Examiner has pointed to nothing in the prior art to substantiate this subjective statement in any way. Consequently, for at least the above reasons, it is respectfully submitted that independent claims 33 and 67 are allowable over the combination of Guyett and McIntyre.

Claims 34-49 and 64-66 depend from claim 33 and claims 68-70 depend from claim 67; and therefore, and is respectfully submitted that these claims are allowable for at least the same reasons as given above for claims 33 and 67.

Additionally, with respect to claims 44 and 46-49, the Office action admits that Guyett does not specify that the game gathers data related to brand type, tag lines, product benefits, imagery, and communication language in particular. The Office action takes Official Notice, and the Applicant now agrees, that it is old and well known that advertisements frequently contain brand type, tag lines, product benefits, imagery, and communication language. But then the final Office action argues that it would have been, therefore, allegedly obvious to one having ordinary skill in the art at the time of the invention was made to gather information related not only to advertisements in general, but also related to the above categories, because "this would allow the advertiser to understand more about how their product is doing in the marketplace." For much the same reasons as given above for claims 33 and 67, the Applicant respectfully disagrees.

Each of the categories of information gathered by claims 44 and 46-49 and missing in Guyett are relevant to the market-research aspect of the present invention as claimed in the pending claims. As discussed above, both Guyett and McIntyre fail to recognize a market-research purpose or benefit. Thus, simply because such categories of data are traditionally present in many forms of advertisements, this certainly does not mean that there exists any teaching or motivation in either Guyett nor McIntyre to gather or process such data. While such a step might be advantageous in subjective hindsight, the Examiner has not shown anything in the prior art that the advertiser even wished to understand how their brand type, tag lines, product benefits, imagery and communication language were being understood or recognized by the ad-viewers/game-players. As

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mentioned above, Guyett collected data to determine a prize amount to the player and McIntyre collected data to calculate a bill. Consequently, it is respectfully submitted that claims 44 and 46-49 are allowable for at least these additional reasons.

Additionally, with respect to claims 64-66/68-70; claims 65/68 recited that the statistical report of claims 33/67 will illustrate a number of first-time accesses of consumers to the interactive advertising message over a period of time; claims 66/69 recite that the statistical report of claims 33/67 will illustrate a comparison of consumers who were able to identify the commercial entity's logo, trademark, trade name, tag line, and/or product name verses a competitor's logo, trademark, trade name, tag line, and/or product name; and claims 66/70 recites that the statistical report of claims 33/67 will illustrate information related to the consumer's interaction time with the interactive advertising message. The final Office action appears to agree that neither Guyett or McIntyre teach such data content in any statistical report, but then argues, citing In re Gulack and In re Lowry, that such differences are "only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The steps would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability..." The Applicant respectfully disagrees.

Each of the recited steps of claims 64-66 and 68-70 are functionally related and involved with the statistical report itself and with the recited step, in claim 33/67, of "gathering data associated with the consumer's interactions with the present interactive advertising message." Thus, claims 64-66 and 68-70 are very much like the claims that the Federal Circuit found *patentable* in In re Gulack. In In re Gulack, The invention-at-issue in In re Gulack the case consisted of (1) a band, ring, or set of concentric rings; (2) a plurality of individual digits imprinted on the band or ring at regularly spaced intervals; and (3) an algorithm by which the appropriate digits are developed. The rejection by the PTO was premised upon the fact that a circular band with items printed upon it was well known in the art. The Federal Circuit *reversed*, finding that the numbers printed on the band had a functional relationship to the band itself. Similarly, in the present case, the

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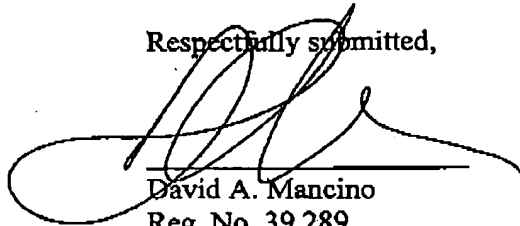
material printed on the statistical report has a functional relationship to the statistical report itself and to the method for generating the statistical report. Consequently, the rejection of claims 64-66 and 68-70 is traversed for at least this additional reason.

Conclusion

In light of the foregoing, it is respectfully submitted that claims 33-49 and 64-70, now pending, are patentably distinct from the references cited and are in condition for allowance. Withdrawal of the rejections of record are respectfully requested. The Commissioner is hereby authorized to charge the additional fees required by this response, or to credit any overpayment to Deposit Account 50-3072.

In the event that the Examiner wishes to discuss any aspect of this response, please contact the undersigned at the telephone number indicated below.

Respectfully submitted,



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